Patent
Attorney's Docket No. 009683-329

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	
	)	
Eiichi SANO et al.	)	Group Art Unit: 2853
	)	
Application No.: 09/057,502	)	Examiner: C. Hallacher
	)	
Filed: April 9, 1998	)	
	)	
For: INK JET PRINTER CAPABLE OF FORMING HIGH DEFINITION IMAGES	)	
	)	
	)	

AMENDMENT/REPLY TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed is a reply for the above-identified patent application.

[ ] A Petition for Extension of Time is also enclosed.

[ ] A Terminal Disclaimer and a check for [ ] $55.00 (248) [ ] $110.00 (148) to cover the requisite Government fee are also enclosed.

[ ] Also enclosed is _____

[ ] Small entity status is hereby claimed.

[ ] Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the[ ] $355.00 (279) [ ] $710.00 (179) fee due under 37 C.F.R. § 1.17(e).

[ ] Applicant(s) previously submitted ___, on ___, for which continued examination is requested.

[ ] A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.

[X] No additional claim fee is required.

[ ] An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× $18.00 (103) =	
Independent Claims		MINUS =		× $80.00 (102) =	
If Amendment adds multiple dependent claims, add $270.00 (104)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					

[ ] A claim fee in the amount of $_____ is enclosed.

[ ] Charge $_____to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: William C Rowland
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Date: July 5, 2001

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7/Response
7/11/01
JMC

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RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Official Action dated April 6, 2001, the Examiner is thanked for the careful examination of the application, and for the withdrawal of the prior rejection. However, in view of the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

Claims 1-3, 5-11, 13-18, and 20-30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,745,131, issued to Kneezel, in view of U.S. Patent No. 5,980,015, issued to Saruta.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must a reasonable expectation of success. Finally, the prior references, when combined, must teach or suggest all of the claim limitations. See section 2142 of the Manual of Patent Examining Procedure.

The Federal Circuit has recently stressed that "our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is vigorous application of requirement for showing of the teaching or motivation to combine prior art references". In re Dembiczak, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999) The Federal Circuit requires that the "showing...the clear and particular." Id.

"Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'". Id. This is precisely the case in the present matter. The Examiner points to no factual basis for combining the two references. The Examiner only makes the broad conclusory statements that it would have been obvious to do so. As such, the Examiner fails to make any particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references, as specifically required by the Federal Circuit.

The Examiner alleges that Kneezel teaches several features of the claim elements, but acknowledges that Kneezel does not disclose that droplets of different sizes are ejected

from a single nozzle, nor does it teach the controlling the position of the smaller dot by changing the speed of the dot by changing the degree in the signal voltage.

To overcome the deficiency of Kneezel, the Examiner relies upon the teachings of Saruta. However, the Examiner has not provided sufficient explanation to justify modifying Kneezel by the teachings of Saruta in order to arrive at the present invention.

Specifically, the Examiner alleges that Saruta discloses an ink jet printer which ejects droplets of different sizes from a single nozzle, and in which the position of a small dot is controlled by changing the speed of the dot by changing the degree in the signal voltage. The Examiner thus concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide speed control of the smaller dot as taught by Saruta, in the ink jet printer of Kneezel, in order to print an image with variable gradation without reducing printing speed. However, even if, as alleged by the Examiner, the speed control of Saruta was applied to Kneezel, there would be no teaching or suggestion to arrive at the present invention. Specifically, Kneezel uses different nozzles for ejecting the smaller dots then it uses for ejecting the larger dots. Accordingly, even if the control of Saruta was applied to Kneezel, Kneezel would still use different nozzles for printing small dots than it uses for printing large dots.

Furthermore, the Examiner alleges that the motivation for applying the control taught by Saruta to the ink jet printer of Kneezel is to print an image with variable gradation without reducing printing speed. However, in view of the fact that Kneezel uses

a plurality of nozzles, it is not understood how the control of Saruta would increase the printing speed of Kneezel. In other words, in view of the fact that Kneezel prints with several nozzles, it is able to print both the small and the large size dots without having to change the printing speed.

Accordingly, the motivation alleged by the Examiner for combining the two references is not relevant to the present situation in view of the fact that the control of Saruta would not increase the printing speed of Kneezel.

The combination applied by the Examiner is a classic example of looking through the prior art with the benefit of the teachings of the present application and selecting the various claim elements from the prior art much like selecting items off of a shopping list. The combination proposed by the Examiner is a classic application of hindsight.

In the event that the Examiner persists with the rejection of the claims based on the proposed combination, the Examiner is specifically requested to point out with greater specificity exactly how the ink jet printer of Kneezel is alleged to be suggested to be modified by the teachings of Saruta. Specifically, the Examiner is respectfully requested to identify specifically what changes to the Kneezel device are suggested by the teachings of Saruta. In addition, the Examiner is specifically requested to point out in what manner Saruta encourages or suggests such changes.

Absent a more detailed explanation, the Examiner is respectfully requested to withdraw the combination and the corresponding rejection.

In the event that there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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